

Accordingly, the subject matter recited in claims 1 and 3-15 and 27-30 is not anticipated by Toida.

Claims 16- 26 positively recite a hoisting winch, including a winch and an electric motor for rotating the winch. Toida fails to disclose or suggest these positively recited claimed features.

The Office Action fails to present any indication of where these features are found in Toida, thereby failing to make out a prima facie case of anticipation of the claimed invention by Toida, and denying Applicant of his fundamental right to both procedural and substantive due process under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Applicant respectfully notes that a winch is conventionally defined as a powerful machine with one or more drums on which to coil a rope, cable or chain for hauling or hoisting. Toida expressly states that its invention "relates to a wheel for a motor vehicle such as electric vehicles, fork lift trucks, and golf carts." - see col. 1, lines 6-7. Toida fails to disclose a winch, or a hoisting winch.

Moreover, claims 16-26 recite, inter alia, "a stator comprising teeth deprived of pole shoes." This feature is not disclosed in Toida.

Accordingly, Toida fails to anticipate the subject matter recited in claims 16-26.

For the aforementioned reasons, Applicant respectfully submits that claims 1, 3-17 and 18-30 are not anticipated by Toida and that the rejection of claims 1, 3-17 and 18-30 under 35 USC §102(b) as anticipated by Toida is improper and must be withdrawn.

The Office Action rejects claims 2 and 17 under 35 USC §103(a) as unpatentable over Toida et al. (hereinafter, "Toida") in view of Abukawa et al. (hereinafter, "Abukawa"). This rejection is respectfully traversed.

Although claim 2 has been canceled, its subject matter has been added to claim 1.

Toida fails to disclose or suggest a number of the recited features of claims 1 and 17, as indicated above. Toida admittedly also fails to disclose a rotor that is a flux concentrating rotor and has magnets disposed between pole pieces.

Abukawa is said to disclose a rotor which is a flux-concentrating rotor and has magnets (21) disposed between pole pieces.

In rejecting claims under 35 USC 103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words

in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). It is well settled that a rejection based on 35 USC 103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

It is impermissible for an Examiner to engage in hindsight reconstruction of the claimed invention using appellant's structure as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik

GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

The only motivation presented in the Office Action for combining these two references in any manner is "to improve the flux concentration between the rotor and the stator of the rotor."

Initially, Applicant respectfully points out that this showing of motivation to combine these two references is not clear and particular, but, rather is a broad conclusory statement about increasing flux concentration and, as such is not proper "evidence" of motivation to combine these references in the manner suggested.

There is no indication in Toida that his device has a need for improved flux concentration, i.e., a problem which would be solved with a rotor of the type disclosed by Abukawa, or that Abukawa's rotor would improve the performance or provide an advantage that would motivate a skilled worker to redesign Toida's rotor and replace it with Abukawa's rotor, or that Toida's device has the problems addressed and/or mitigated by Abukawa.

The Office Action simply fails to demonstrate the desirability of combining these references.

Accordingly, the Office Action fails to make out a prima facie case of obviousness of the claimed invention.

Furthermore, Applicant respectfully notes that Abukawa's rotor does not have pole pieces with magnets radially disposed between the pole pieces, as claimed, and contends that the Office Action does not establish that Abukawa discloses or suggests a permanent magnetic flux-concentrating rotor.

Thus, even if one of ordinary skill in the art were to somehow combine Toida and Abukawa, the resulting combination would not disclose or suggest the claimed invention.

Accordingly, the subject matter of claim 2 (now incorporated into claim 1) and 17 is not rendered obvious by Toida and/or Abukawa, and the rejection of claims 2 and 17 under 35 USC §103(a) as unpatentable over Toida in view of Abukawa is improper and should be withdrawn.

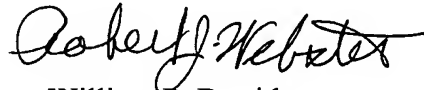
Claim 31 recites, inter alia, a "driving wheel comprising . . . a step down gearing coupling the motor to the wheel, said step down gearing comprising an epicyclic gear train . . .", which is not disclosed by Toida or Abukawa.

Toida discloses a double reduction gear reducer, which is discussed in col. 5, line 61, and shown in Fig. 3, but does not disclose a gear comprising an epicyclic gear train, as recited in claim 31. Accordingly, the subject matter recited in claim 31 is patentably distinct from Toida and/or Abukawa.

For the aforementioned reasons, Applicant respectfully submits that claims 1-31 are patentable over the applied references. Reconsideration of the Application and prompt allowance of claims 1-31 is earnestly solicited.

Should the Examiner believe that there is anything further that may be needed to place the application in even better condition for allowance, the examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,



William P. Berridge
Registration No. 30,024

Robert J. Webster
Registration No. 46,472

WPB:RJW/sxb

Enclosure:
Appendix

Date: January 17, 2003

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--